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**PATENT APPLICATION**

~~11/2829~~



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Pre Application of:  
KEISHI DANJO ET AL.

Application No.: 09/846,555

Filed: April 30, 2001

For: SUBSTRATE FOR FORMING AN ELECTRON SOURCE, ELECTRON SOURCE, AND IMAGE DISPLAY DEVICE

Mail Stop  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT  
AND (CONDITIONAL) PETITION UNDER 37 C.F.R. § 1.181

Siri

This paper is filed in response to the Office Action dated April 6, 2005, which required a restriction between the following allegedly patentably distinct groups of claims:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

May 6, 2005.  
(Date of Deposit)

Frank A. DeLucia (Reg. No. 42,476)  
(Name of Attorney for Applicants)

### Curvature

May 6, 2005  
Date of Signature

1. Group I, Claims 5, 6, and 8-27, drawn to a precursor, classified in class 428, subclass 447; and
2. Group II, Claims 28-34, drawn to an electron source and image display device, classified in class 313, subclass 495.

The Office Action apparently deems the Group II claims as being “combination” claims, and the Group I claims as being “subcombination” claims, and bases the restriction requirement on the test given in MPEP §806.05(c).

Initially, Applicants provisionally elect to proceed with examination of Group II (Claims 28-34), subject to the below traversal.

Applicants believe, and respectfully submit, that the Examiner has misapplied the test for determining whether there is a combination and subcombination which would justify a restriction between the Group I and II claims. As was stated in the Response filed on November 1, 2004, the proper test is whether the combination requires the particulars of the subcombination for patentability, and whether the subcombination has utility by itself or in other combinations (MPEP §806.05(c)). Thus, to support a restriction based on an alleged combination and subcombination, an examiner must show, among other things, that the combination is patentable over the prior art even without the particulars of the subcombination. It is respectfully submitted that the Office Action has not sufficiently presented such a showing. Indeed, with regard to application of the first part of the test to Groups I and II, the Office Action states merely that:

““the combination as claimed does not require the particulars of the subcombination as claimed because the electron source or image display device of Group II does not require the metal oxide ....” (Page 3 of Office Action)

However, this reasoning is believed flawed firstly because some of the alleged “subcombination” claims do not even explicitly recite a “metal oxide”, and thus they do not necessarily require that particular either (see, in particular, Claims 11, 12, 18, 19, 20, and 21).

Second, the Group II claims *do* require the particulars of the Group I claims because the Group II claims *depend, directly or indirectly, from Group I claims*, and thereby incorporate the particulars of the Group I claims. For example, Group II Claims 28 and 31 each depend from any one of Claims 5, 6, 11-15, and 18-24, all of which are Group I claims. Group II Claims 29 and 30 each depend from Claim 28 (and thus depend indirectly from any one of Group I Claims 5, 6, 11-15, and 18-24), and Group II Claims 32-34 each depend from Claim 31 (and thus also depend indirectly from any one of Group I Claims 5, 6, 11-15, and 18-24). Therefore, because all of the Group II claims depend directly or indirectly from Group I claims, the Group II claims clearly *do require* the particulars of Group I claims.

Furthermore, the Office Action is not seen to explain how the Group II (combination) claims, which each depend from Group I (subcombination) claims, can be patentable over the prior art without the particulars of the Group I claims.

For all of the foregoing reasons, it is believed that the Office Action has failed to establish a proper justification for the two-way restriction requirement, and withdrawal of the restriction requirement is therefore respectfully requested.

If the Examiner is not persuaded to remove the restriction requirement in view of the foregoing remarks, he is respectfully requested to explain why he believes that the Group II claims each do not require the particulars of the Group I claims for

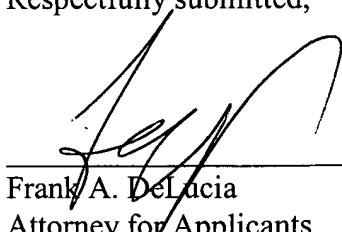
*patentability* (i.e., how the Group II claims could be patentable over the prior art without the particulars of the Group I claims). Also if the Examiner is not persuaded to withdraw the restriction requirement in view of the above remarks, this paper should be treated as a Petition to invoke the supervisory authority of the Commissioner under 37 C.F.R. § 1.181, and should be forwarded with the filewrapper to the appropriate Patent and Trademark Office official for reconsideration of the restriction requirement in view of the above remarks.

Although no fee is believed due in connection with this Petition in view of the apparently improper restriction requirement issued by the Patent and Trademark Office, any fee that may be deemed required may be charged to Deposit Account No. 06-1205.

Applicants respectfully request favorable reconsideration and an early and favorable action on the merits of all presently pending claims.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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